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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,338	06/26/2003	Shin Nishizawa	P 0304519 H7952	5585
7590 Pillsbury Winthrop LLP Intellectual Property Group Suite 2800 725 South Figueroa Street Los Angeles, CA 90017-5406			EXAMINER ZHAO, DAQUAN	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 09/16/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,338

Applicant(s)

NISHIZAWA, SHIN

Examiner

DAQUAN ZHAO

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date 7/14/2008

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/14/2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3 and 5-14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 6-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For claims 6-14, the term "computer readable recording medium" is not defined. The examiner considers the "computer readable recording medium" as claimed as a signal claim, wherein there's no support in the specification for the "computer readable recording medium" to be a signal.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 3, 5, 6, 7, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al (US 6,560,407 B2), in view of Anderson et al (US 2003/0,194,214 A1) and further in view of Onodera et al (US 7,331,055 B2).

Regarding claim 1, Maruyama et al teach a method of controlling an operation of an optical disc recording apparatus capable of recording record information onto an optical disc and forming an image corresponding to image information on the optical disc (e.g. column 28, line 25- column, line 29, line 20), the method comprising the steps of: determining an operation of recording the record information by the optical disc recording apparatus (e.g. user determine the recording mode to record data on the DVD, wherein the data includes recording average bit rate, recording channel number, recording data/time...etc, which corresponds to the "record information") and an

operation of forming the image corresponding to the image information by the optical disc recording apparatus (e.g. column 30, line 15- column 31, line 28, the representative picture data are printed on the surface of the optical disc 10, also see figure 21); and

giving instructions for starting recording of the record information and instructions for starting formation of the image corresponding to the image information to the optical disc recording apparatus after the determining step (e.g. column 30, line 15- column 31, line 28, the representative picture data are printed on the surface of the optical disc 10, also see figure 21).

However, Maruyama et al fail to teach the recording information is recorded and the image is formed on the recording face of the optical disc by applying a laser beam; and displaying preview display which reflecting the determined record information and the determined image. Anderson et al teach the recording information is recorded and the image is formed on the same side of the optical disc by applying a laser beam (e.g. see abstract and paragraph [0028]). It would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the teaching of Anderson et al into the teaching of Maruyama et al for users to conveniently to manage their disc files (Anderson et al, paragraph [0003]).

Maruyama et al and Anderson et al fail to teach displaying preview display which reflecting the determined record information and the determined image. Onodera et al teach displaying preview display which reflecting the determined record information and the determined image (e.g. 12, step 122, figure 13b and column 12, lines 27-42). It would have been obvious to one ordinary skill in the art at the time the invention

was made to incorporate the teaching of Onodera et al into the teaching of Maruyama et al and Anderson et al to assist the user to preview, in advance the size and position of the label printed on the optical to increase the system accuracy (Onodera et al, column 12, lines 43-45).

Claim 6 is rejected for the same reasons as discussed in claim 1 above.

Claim 3 is rejected for the same reasons as discussed in claim 1 above with further limitation: displaying on the display an optical disc information reflecting the record information and the image which are determined by the user (see figures 21 and 22, display print menu frame).

Regarding claim 5, Maruyama et al teach a step of urging the user to determine whether the recording and forming step is to be executed based on the optical disc information (e.g. user gives instruction by pressing key 5pri of the remote controller 5 in step ST1 of figure 21, also see figure 20).

Regarding claim 7, Maruyama et al teach a notifying function of requesting an input of setting information which is necessary for determining the recording operation and the image forming operation by the optical recording apparatus (e.g. figure 21, step ST2 shows the display print menu frame to notifying user what the printing data on the disc would be), and

wherein the operation determining step includes a step of determining the operation of recording the record information (e.g. user presses the "record button" on the remote controller) and determining the operation of forming the image in accordance

with the input setting information before the instructing step (e.g. user presses the print button after the print menu frame is displayed).

Regarding claim 8, Maruyama et al teach a first obtaining step of obtaining an information amount of designated record information and an information amount of designated image information, and a notifying function of notifying the information amounts of the information which are obtained by the first obtaining function, and wherein setting information includes at least record file information for designating record information and image file information for designating image information (e.g. column 31, lines 28-45, and figure 23c, the amount used for storing the image is considered to be the “an information amount of designated record information and an information amount of designated image information”, wherein “an information amount of designated image information” is considered not differ from “an information amount of designated record information” because the image is recorded).

Regarding claim 9, Maruyama et al teach the program further causes the computer to execute: a first obtaining step of obtaining an information amount of designated record information and an information amount of designated image information; a second obtaining step of obtaining a free area of the optical disc; and a notifying step of comparing a total of the information amounts of the information which are obtained in the first obtaining step with the free area which is obtained in the second obtaining step, and, when the total of the information amounts is larger than the free area, notifying that the total of the information amounts is larger than the free area, and wherein the setting information includes at least record file information for designating

record information and image file information for designating image information (e.g. column 31, lines 28-45, and figure 23, user visually compares the used and unused amount in contract with each other. the amount used for storing the image is considered to be the "an information amount of designated record information and an information amount of designated image information", wherein "an information amount of designated image information" is considered not differ from "an information amount of designated record information" because the image is recorded).

Regarding claim 2, Maruyama et al teach the operation of recording the record information is determined after the operation of forming the image is determined (e.g. user can determine press either the "record" button or the "print" first and then the other one next).

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al (US 6,560,407 B2), Anderson et al (US 2003/0,194,214 A1) and Onodera et al (US 7,331,055 B2), as applied to claims 1, 2, 3, 5, 6, 7, 8 and 9 above, and further in view of Honda et al (US 7,015,939 B2).

See the teaching of Maruyama et al, Anderson et al and Onodera et al above.

For claim 13, Maruyama et al, Anderson et al and Onodera et al fail to teach a pattern of an image formation. Honda et al teach writing different pattern of image on the surface of the disk (e.g. see figure 12A-C, column 10, line 59- column 11, line 2, and column 2, lines 11-20). It would have been obvious for one ordinary skill in the art at the time the invention was made to indicate a pattern of an image information to be form on

the optical disc to obviating a necessity of the user for writing of an image performed with a pen (e.g. Honda et al, column 1, lines 35-45).

8. Claims 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al (US 6,560,407 B2), Anderson et al (US 2003/0,194,214 A1) and Onodera et al (US 7,331,055 B2), as applied to claims 1, 2, 3, 5, 6, 7, 8 and 9 above.

See the teaching of Maruyama et al, Anderson et al and Onodera et al above.

For claims 10 and 12, Maruyama et al and Anderson et al fail to teach editing the information. It is noted that editing the information is well known in the art. The examiner takes official notice for it. It would have been obvious for one ordinary skill in the art at the time the invention was made to edit the information in accordance with a result of comparison between the information amounts of the information obtained in the first obtaining step, and the free area obtained in the second obtaining step to avoid recording error due to insufficient storage space.

For claim 11, Maruyama et al teach the total of the information amounts of the information is larger than the free area as a result of the comparison between the information amounts of the information obtained in the first obtaining step and the free area obtained in the second obtaining function (e.g. column 31, lines 29-45, and figure 22 A-C, user visually compare the used and unused storage amount).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maruyama et al (US 6,560,407 B2), Anderson et al (US 2003/0,194,214 A1) and

Onodera et al (US 7,331,055 B2), as applied to claims 1, 2, 3, 5, 6, 7, 8, 9, 10,11, and 12 above, and further in view of Honda et al (US 7,015,939 B2).

See the teaching of Maruyama et al, Anderson et al and Onodera et al above.

For claim 14, Maruyama et al and Anderson et al fail to teach a pattern of an image formation. Honda et al teach writing different pattern of image on the surface of the disk (e.g. see figure 12A-C, column 10, line 59- column 11, line 2, and column 2, lines 11-20). It would have been obvious for one ordinary skill in the art at the time the invention was made to indicate a pattern of an image information to be form on the optical disc to obviating a necessity of the user for writing of an image performed with a pen (e.g. Honda et al, column 1, lines 35-45).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621
Daquan Zhao

/Thai Tran/
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